

REMARKS

Upon entry of the present amendment, claim 1 will have been amended by incorporating the features of claim 6 therein. Claim 6 will have been cancelled and claims 7-12 will have been amended. Further, new claims 13-21 will have been submitted for consideration by the Examiner.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of each of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant respectfully thanks the Examiner for considering the documents cited in the Information Disclosure Statement filed on October 14, 2003. Applicant further thanks the Examiner for noting Applicant's Claim for Foreign Priority. Applicant further respectfully requests the Examiner to confirm that the certified copy of Applicant's foreign priority document has been received in the present application. The certified copy was filed concurrently with the present application on July 11, 2003.

In the outstanding Official Action, the Examiner rejected claims 1-7, 9, 10 and 11 under 35 U.S.C. § 102(e) as being anticipated by MARUCCI et al. (U.S. Patent No. 6,582,451). Claims 8 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MARUCCI et al. in view of MAYENBERGER (U.S. Patent No. 5,853,412). Applicant respectfully traverses each of these rejections and submits that the reference or the references relied upon do not teach, disclose nor render obvious the combination of features recited in Applicant's claims. Accordingly, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Applicant's claim 1, which has been amended to include the features of claim 6, defines, inter alia, a pair of manipulation members which comprise a pair of electrodes and the spacer insulating the electrodes from each other. It is respectfully submitted that at least these features, in the claimed combination, are not taught, disclosed nor rendered obvious by MARUCCI et al. relied upon by the Examiner.

In addressing these features, the Examiner directed Applicant's attention to column 6, lines 33-40 of MARUCCI et al. However, it is respectfully submitted that this portion of MARUCCI et al. does not teach, disclose nor render obvious the features now recited in Applicant's claim 1. In particular, MARUCCI et al. discloses that in one embodiment, "the jaw members may act as platforms for diagnostic or therapeutic modalities including but not limited to: ultrasound, lithotripsy, radiotherapy, radiofrequency, unipolar/bipolar electrocautery".

However, Applicant respectfully submits that there is a significant difference between the manipulation members comprising a pair of electrodes and the jaws acting as "platforms" for these various therapeutic modalities. Applicant's claims are not reciting that the manipulation members are platforms (i.e., supports) for electrodes but rather that the manipulation members comprise electrodes. It is respectfully submitted that there is no disclosure or teaching of this explicitly recited feature in MARUCCI et al. Accordingly, for this reason alone, it is respectfully submitted that claim 1 is clearly patentable over MARUCCI et al.

Independently of the above, Applicant's claim 1 further recites that the spacer insulates the electrodes from each other. There is additionally no teaching or disclosure of this feature in the relied upon MARUCCI et al. reference. In this regard, as Applicant noted above, MARUCCI et al. merely discloses that the electrodes can be platforms for

a therapeutic modality such as electrocautery. However, because according to the teachings of MARUCCI et al., the jaws (or manipulation members) are not the electrodes, there is no reason whatsoever for the spacer (which the Examiner reads on the linkage 24, 25) to comprise an insulating material.

In direct contrast, since in Applicant's invention the manipulation members comprise the electrodes, the spacer must insulate them from each other in order to avoid short circuiting between the manipulation members.

In this regard Applicant notes the Examiner's reliance on column 12, lines 36-41 regarding the use of various plastics. However, because of the recited features of Applicant's invention, the spacer must be an insulator while the electrodes must be conductive. The cited portion of MARUCCI et al. merely indicates that the components of the device may be formed of appropriate materials including stainless steel, atraumatic plastic, or one of various alloys. Further, MARUCCI et al. discloses that, in the alternative, "the device may be manufactured such that each component is made up of a different material to the others". However, such a broad disclosure is merely an invitation to one of ordinary skill in the art to invent and is not a disclosure that anticipates or renders unpatentable the specific recited features of Applicant's invention.

Independently of the above, claim 1 recites the manipulation members "pivotally" supported by said shaft. However, in MARUCCI et al., the jaws do not pivot about the shaft (28 according to the Examiner) but moving parallel to each other via the parallelogram linkage 24, 25.

For each of the above reasons and certainly for all of the above reasons, it is respectfully submitted that claim 1 is clearly patentable over the MARUCCI et al. reference relied upon by the Examiner in the outstanding Official Action.

By the present Response, Applicant has further amended various claims to improve the form thereof and to render the same more particularly descriptive of Applicant's invention without in any manner narrowing the scope thereof. Such changes are intended to expedite and facilitate the examination of the present application towards allowance.

By the present Response, Applicant has submitted several additional claims for consideration by the Examiner. In this regard, each of these claims is patentable based on its own recitations as well as based upon its depending from a shown to be allowable claim 1. Applicant has further submitted a new independent claim for consideration by the Examiner. It is respectfully submitted that this claim is clearly patentable over the MARUCCI et al. reference relied upon by the Examiner. In this regard, Applicant notes that in setting forth the MARUCCI et al. reference, the Examiner asserted that the recited spacer comprises the articulated linkage 24, 25. Newly submitted claim 19 recites the spacer as being fixedly positioned with respect to the support member. Accordingly, it is respectfully submitted that claim 19 is clearly patentable over the MARUCCI et al. reference relied upon by the Examiner. An action to such effect is respectfully requested in due course.

Accordingly, Applicant respectfully requests reconsideration of each of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claim 1 to incorporate the features of claim 6 therein and has traversed the Examiner's rejection. Applicant has pointed out the significant and substantial shortcomings of the reference relied upon by the Examiner with respect to the pending claims. Applicant has further discussed the explicitly recited features of Applicant's claims and has noted the shortcomings of the relied upon reference with respect thereto. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.


Applicant has further submitted several additional claims for consideration by the Examiner and with respect to these claims has provided a basis for the patentability thereof.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

September 22, 2005
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